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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,741	06/20/2001	Paul Andrew Moskowitz	YOR920010305US1	5584

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/885,741

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" in claims 5 and 29 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 4, 7, 8, 13-17, 19, 21-27, 30, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Call (US 6,418,441 B1).**

Referring to claims 1, 7, 8, 13-17, 19, 21-23, 26, 27, 30, and 34 Call teaches a system, method, and program comprising: reading a product identification token

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associated with the product wherein the product identification token identifies a location from which product information may be retrieved (column 1, line 59 column 2, line 48; column 4, lines 1-46); retrieving the product information associated with the product using the product identification token; and presenting the product information to a user (column 4, lines 1-46). Call does not teach that the product information is an evaluation/registration form. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of reading, retrieving, and presenting would be performed the same regardless of what information the token identified. The differences between the Applicants' evaluation/registration form and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Furthermore, Call teaches that the type of information made available to a user is "...completely under the control of [the] manufacturer." (column 10, lines 1-32). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to retrieve any type of information in the invention of Call because such information does not functionally relate to the elements of the claimed method and system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 3, 24, 32, Call teaches reading the product identification token comprises optically scanning the product identification token (column 12, lines 39-49).

Referring to claims 4, 25, 33, Call does not teach that the product identification token is a radio frequency identification tag and reading the product identification token comprises reading the radio frequency identification tag. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate RFID into the invention of Call. Applicants have not disclosed that an RFID provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with a UPC because both uniquely identify a product. Therefore, it would have been obvious to one of ordinary skill in this art to modify Call to obtain the invention as specified in the claims.

**Claims 2, 12, 18, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Call (US 6,418,441 B1) in view of Golightly (US 4,993,714).**

Referring to claims 2, 12, 18, 28, Call does not teach reading a receipt identification token on a receipt corresponding to the product, wherein the receipt identification token provides receipt purchase information; and entering the purchase information into the product evaluation form. However, Golightly teaches this limitation (column 1, lines 44-62; column 2, line 13 – column 3, lines 4; Figures 3 and 4). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Golightly into the invention of Call.

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One of ordinary skill in the art would have been motivated to do so in order to retrieve product information by scanning the UPC number from the receipt.

**Claims 6, 9-11, 20, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Call (US 6,418,441 B1) in view of Official Notice.**

Call does not teach providing a reward to the user upon completion of a product evaluation form wherein the reward includes at least one of a coupon, a discount on a product, cash, frequent flyer mileage, credits towards goods, and credits towards services; and wherein the product evaluation form includes a set of questions.

However, Official Notice is taken that these features are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the invention of Call. One of ordinary skill in the art would have been motivated to do so in order to provide a user with an incentive to take the time to answer a series of questions.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

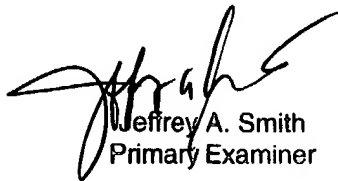
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

June 11, 2004



Jeffrey A. Smith  
Primary Examiner